



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SK

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/877,155	06/17/97	CORMIER	M ARC2466R1

D BYRON MILLER
ALZA CORPORATION
950 PAGE MILL ROAD
PALO ALTO CA 94303-0802

QM12/0309

EXAMINER

KENNEDY, S

ART UNIT

PAPER NUMBER

3763 21

DATE MAILED:

03/09/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/877,155

Applicant(s)
Cormier et al

Examiner
Sharon Kennedy

Group Art Unit
3763



☒ Responsive to communication(s) filed on Nov 26, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 6, 7, 30, 31, 53-55, 57-74, and 76-103 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 6, 7, 30, 31, 53-55, 57-74, and 76-103 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Status of the Application

2. This office action is responsive to the amendment filed November 26, 1999, which should have been considered prior to the office action mailed December 6, 1999. The amendment was not placed in the file until after the rejection was mailed.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification lacks antecedent basis for "said anchor *helps prevent* the sheet from being dislodged" and for the subject matter added in claim 80.

Claim Rejections - 35 USC § 112

4. Claims 58 and 77 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a device wherein the anchor is a prong, does not reasonably provide enablement for the device having a prong which is not an anchor. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. In other words, the claim implies that the prong is not an anchor and can include prongs used to attach the device to other objects. This is not enabled and in addition the claim makes it impossible to

discern the scope of the invention, ie., whether it is in accordance with the teachings of the specification or includes some other as yet unimagined form. See also the rejection below.

5. Claims 6, 7, 30, 31, 53-55, 57-74, 76-114 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. See the comments set forth in the office action mailed December 6, 1999. In addition, the scope of the "prong" as recited in claims 58 and 77 is unclear since it is not in harmony with the teachings of the specification. Thus, it is unclear if the specification should be used to interpret the prong or if the prong can be other than an anchor. The unclearness of the claim is aggravated by applicant's claim amendment which implies that the prong is now not an anchor.

Claim Rejections - 35 USC § 102

6. Claims 6, 7, 30, 31, 53-55, 57, 59-62, 65-68, 71-74, 76, 78, 80, 83-86, 89-94, 98-100 are rejected under 35 U.S.C. 102(b) as being anticipated by Ganderton et al., 3,814,097. See the comments set forth in the previous office actions.

7. Claims 6, 55, 57, 59, 64-66, 71 and 72 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Reed et al., U.S. 5,312,456. The comments set forth in the previous office actions are incorporated herein.

Claim Rejections - 35 USC § 103

8. Claims 63, 64, 69, 70, 81, 82, 87, 88, 95, 96, 97, 101-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ganderton et al., U.S. 3,814,097. The comments set forth in the previous office actions are incorporated herein.

9. Claims 7, 63, 69 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 5,312,456. The comments set forth in the previous office actions are incorporated herein.

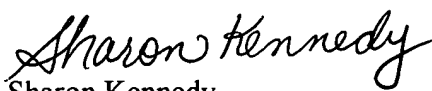
Allowable Subject Matter

10. Claims 58, 77, 79 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the

Response to Arguments

11. Applicant's arguments filed November 26, 1999 have been fully considered but they are not persuasive. Applicant's comments regarding the shape of the hole are non-persuasive for the following reasons. First, applicant's arguments are speculation set forth by a lay-person (an attorney) and cannot be accorded serious consideration in the lack of an affidavit by one of at least ordinary skill in the art. In addition, note that the Ganderton burr is longer than the diameter of the hole produced, which means that the metal was stretched to a breaking point and not cleanly punched. Thus, it appears conclusive that at least some projections extend around the hole. Secondly, this is not the only portion of Ganderton which anticipates the claimed invention. See, for example, column 2, line 65 to column 3, line 2, the nettles in column 2, line 13, etc. Accordingly, applicant's comments do not address the entirety of the Ganderton patent. Thirdly, the comments are not commensurate with the scope of the claims, which do not require anything about several blades extending from a single orifice. Thus, the comments are non-persuasive.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon Kennedy whose telephone number is (703) 305-0154.


Sharon Kennedy

March 9, 2000